UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,267	01/02/2002	Tom Howard	10011529-1	6181

7590 01/13/2006

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EXAMINER
SZYMANSKI, THOMAS M

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/037,267	HOWARD ET AL.
	Examiner	Art Unit	
	Thomas Szymanski	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) *8, 10 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 9, 11-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-20 have been examined.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
>
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
>
> the prior art are such that the subject matter as a whole would have been obvious at the time the
>
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
>
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-7, 9, and 11-19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hasebe U.S. Patent No. 5,987,609, in view of Davis et al United

States Patent Application Publication No. 2002/0004905, and further in view of Barrus

et al U.S. Publication No. 2001/0045884

4.   Hasebe has implemented a system that provides for securing the device while

running but fails to teach checking the integrity of the system prior to booting for

identification of a tampered system.

5.   Davis et al provides for a system within which the integrity of the system is

checked for security purposes prior to booting the system (Davis et al paragraph 0018)

6.   Within any system containing data or sensitive access to a system strong

security functionality is always desirable to prevent unauthorized acquisition and use of

the device and its contents. (Davis et al pg 1 paragraphs 0004-0009)

7.   It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to combine the system of Davis et al with that of Hasebe for the

improved security functionality that is obtained from preventing access to the system

while it is not connected to the network by the implementation of the integrity checking

of the firmware within the system. The Davis et al system when implemented with

Hasebe would check the firmware which within the implementation of Hasebe et al

consists of all that is necessary for the operation of the system which is all of that which

is contained on ROM and RAM (Hasebe Fig 3, 12 and 13)

8.   Hasebe and Davis have provided a system that provides for storing information

in non-volatile memory, but does not explicitly state that the memory is Flash Memory.

9.   Barrus et al provides for a system within which a security protocol is implemented

with Flash memory (pg. 2 paragraph 0016).

10.   It is desirable within a security system to be able to implement proactive steps for

purposes of improved security, it is especially advantageous to be able to obtain any

information as to the possession and or location of such a device when it is in an

unauthorized state.

11.   It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to combine the system of Barrus et al with that of the

Hasebe/Davis combination. The combination of these two systems forms a better

system with improved security measures and thus greater data integrity.

12.   Regarding Claim 1: A device for preventing unauthorized use (Col 5 lines 56-67

Col 6 lines 1-67)

Processor (Col 4 lines 47-48)

Wireless communication subsystem (Col 4 lines 37-46)

Security protocol operable to prevent execution of software upon receiving a message

(Col 3 lines 21-37, Col 6 lines 44-55 Fig 6) As provided for by Hasebe the security

process as implemented allows for prevention of the execution of software by only

displaying that which has been selected by the user in fig 6 and not the execution of any

phone functions as such preventing execution of software by the implemented security

protocol.

13.   Regarding Claim 2: Non-volatile memory for storing information to indicate

software is not permitted for execution (Col 4 line 45 – Col 6 line 65) As the

combination teaches the use of non-volatile flash memory is used for what would have

been previously stored on ROM and RAM for the advantages outlined by Barrus.

(Barrus paragraphs 4-7, and 16-20)

14.   Regarding Claim 4: Preventing access to user data (Fig 6, Col 6 lines 32-59)

Hasebe describes several forms of preventing access to the data, one being locking the

system and another being deletion of files upon recognition of the device being

compromised.

15.   Regarding Claim 5: Protocol causes application to exit if message received while

running (Col 5 lines 65-67, Col 6 lines 1-7, 23-67) The functionality of the system

requires that the program exit while running as that is the manner in which it must

operate. Since the system must be on to receive messages in order to function it must

then exit the running normal state in order to implement the selected security level.

16.   Regarding Claim 6: A display for presenting an unauthorized message (Fig 3

part 17, Col 6 lines 49-55)

17.   Regarding Claim 7: Implementation within an operating system (Fig 3, Col 5

lines 56-67 Col 6 lines 1-67) The system must have an operating system as it would

otherwise not function. The security protocol must be implemented within the operating

system as it is part of the system and wouldn't have functionality independently. As it

can be seen from Fig 3 part 12 the system software is contained together as separate

modules reliant upon the operating system.

18.   Claims 9, 11-15 and 16-19 are a method and system implementation of claims 1-

7; therefore, claims 9, 11-15 and 16-19 are rejected on the same grounds.

Response to Arguments

19.   Applicant's arguments filed 11/10/2005 have been fully considered but they are

not persuasive. The applicant has amended claim 1 in light of the arguments presented

on the grounds that neither Hasebe nor Davis teach the claimed invention.

20.   In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).

21.   The examiner respectfully asserts that the combination of Hasebe and Davis

does teach a BIOS and authentication of a security protocol prior to boot. The

combined system teaches a BIOS as is shown within the background and specification

of Davis and furthermore a BIOS that is operable to be verified before being completely

loaded as stated within the present invention. In the case of this combination the BIOS

itself is inclusive to a security protocol as the software is responsible for access and

loading of the system (Davis Paragraphs 4-10) and as stated contains built in security

methods lending itself to be understood as a security protocol by the broadest

reasonable interpretation of the applicant's claim.

22.   With regard to applicant's argument of amended claim 9, Hasebe references the

necessary security level, contained in RAM, and the processors comparison of that to

the provided information, (Col 4 line 45 – Col 6 line 65). When in combination with the

reference of Davis et al this clearly teaches the use of non-volatile memory to store

information relating to the access of the system.

23.   The applicant's recitation of the security protocol not being implemented by an

operating system within the combined system is respectfully traversed. The system

clearly utilizes software to operate. This software, being the operating system, includes

the routines that are defined as the security protocol and as taught by Hasebe and the

combined reference are inherently included and implemented by such an operating

system. Additionally, the assertion that running on top of the OS is not the same as

being implemented by the OS is not discernable from the claim language presented and

furthermore, running any software on top of an OS still denotes that the OS is required

for the implementation and uses parts thereof just the same as being implemented by

the OS and as such is anticipated by the reference.

24.   With regards to applicant's argument of the rejection of claims 9-20 it is clear that

such claims must be of the same scope as the alternative set (1-8), otherwise such

claims are clearly of separate inventions and restrictable. The language and ordering of

such claims although not exact is the same, merely stated in the separate context of a

method and system but still providing no distinct new matter from the base claims of 1-8

and as such are rejected in the same spirit as those claims.

Conclusion

25.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
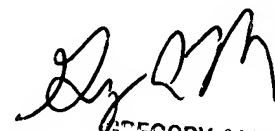
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Szymanski whose telephone number is 571-272-8574. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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